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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,752	07/01/2003	Olivier Cohu	ICH 296-US	5032
25230	7590	08/22/2006		
ONOFRIO LAW 107 SHAD ROW PIERMONT, NY 10968			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER

1762

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/611,752

Applicant(s)

COHU, OLIVIER

Examiner

William P. Fletcher III

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 15 and 16.  
Claim(s) rejected: 1-14.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

08/17/2006  
  
William Phillip Fletcher III  
Patent Examiner (FSA), USPTO  
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Continuation of 3. NOTE:

Applicant's amendment and remarks after-final are noted, but the amendment does not place the application in condition for allowance and will not be entered.

With respect to claim 1, if amended as proposed, this claim would be limited to the following nanoporous inorganic compounds:

wherein the nanocrystalline, nanoporous inorganic compound is TiO<sub>2</sub>, Ti<sub>2</sub>O<sub>3</sub>, Nb<sub>2</sub>O<sub>5</sub>, WO<sub>3</sub>, V<sub>2</sub>O<sub>5</sub>, MoO<sub>3</sub>, MnO<sub>2</sub>, HfO<sub>2</sub>, TiS<sub>2</sub>, WS<sub>2</sub>, TiSe<sub>2</sub>, Fe<sub>2</sub>O<sub>3</sub>, Fe<sub>3</sub>O<sub>4</sub>, RuO<sub>2</sub>, RuS<sub>2</sub>, MoS<sub>2</sub>, WS<sub>2</sub>, IrO<sub>2</sub>, CeO<sub>2</sub>, InO<sub>2</sub>, TaO<sub>2</sub>, ZnO, SnO<sub>2</sub>, BaTiO<sub>3</sub>, SrTiO<sub>3</sub>, indium-tin-oxide, LiMn<sub>2</sub>O<sub>4</sub>, LiNiO<sub>2</sub>, LiCoO<sub>2</sub> or Li(NiCo)O<sub>2</sub>;

This list *excludes* the various aluminum compounds recited in claims 8-11 and the colloidal silicon dioxide recited in claims 12-13. A dependent claim must further limit the claim(s) from which it depends. See 37 CFR 1.75(c). Further, the proposed amendment to claim 1 raises a possible new matter/scope of enablement issue. The nanoporous compounds of the above list are disclosed in the specification solely in relation to the formation of electrically active films. See page 9, lines 15-22. The scope of claim 1, if amended as proposed, is open to the formation of any and all films, including non-electrically active ones. It is not clear whether the instant specification supports and/or enables a claim of this scope. Consequently, the proposed amendment to this claim raises new issues requiring further consideration and/or search.

With respect to claim 16, if amended as proposed, this claim would be of a scope not heretofore considered by the examiner. As noted in the "Allowable Subject Matter" section

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of the prior Office action, the claim must be written in independent form to include the limitations of the independent claim and all intervening claims. Original claim 16 depended from original claim 15. The subject matter of original claim 15 is *not* recited in the proposed amendment to claim 16. Hence, it is of an entirely new scope not heretofore considered by the examiner, requiring further consideration and/or search; or, at least, it is not of the form indicated allowable in the prior Office action.

Continuation of 11.

Applicant's arguments in the request for reconsideration are directed solely to the claims if amended as proposed. As detailed above, the proposed amendment will not be entered.

A handwritten signature "WPF" and the date "08/17/2006" are enclosed within a hand-drawn oval.